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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,162	11/10/2000	Guillermo J. Tearney	187718/US - 475387-00245	3219
30873	7590	11/20/2006	EXAMINER	
DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT 250 PARK AVENUE NEW YORK, NY 10177			KISH, JAMES M	
			ART UNIT	PAPER NUMBER
			3737	

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/709,162

Applicant(s)

TEARNEY ET AL.

Examiner

James Kish

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 68-136 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 68-136 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/11/06, 9/18/06</u> | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Claims 1-67 have been cancelled and therefore, the rejections on said claims have been withdrawn. However, there are new grounds of rejection for newly added claims 68-136 as follows.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 68-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boppart et al. (US Patent No. 6,485,413) in view of Williams (US Patent No. 5,801,826). Boppart discloses an imaging system for performing forward scanning imaging for application to therapeutic and diagnostic devices. There is a lens arrangement as can be seen in Figure 2, items 26 and 30. Also, as Examiner Mercader has previously demonstrated the interferometer of Boppart is itself a dispersive element as evidenced by Williams (see column 3, line 65 through column 4, line 8 of Williams). The interferometer of Boppart may contain free-space optics and/or optical fibers (column 5, lines 14-15). The computer controls the interaction between transverse and depth scanning to generate 1, 2 or 3 dimensional images (column 5, lines 31-43). In the reference arm scanning OCT embodiment, a broad-bandwidth optical source is used

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and coupled to the interferometer (column 5, lines 47-49). In another embodiment of the optical imaging system, the scanning mechanism includes counter rotating prisms or rotating offset lenses that generate arbitrary scanning patterns on a sample (column 2, lines 62-65). The imaging system described has application to hand-held probes, laparoscopes, endoscopes, catheters, tissue probes, needles, and other instruments either as "stand-alone" implementation or as a new implementation used in conjunction within, or external to, an existing instrument (column 2, lines 30-38). Boppart discusses a method to cover a large area of the structure being imaged at column 32, lines 45-54. It would have been obvious to one skilled in the art at the time the invention was made that an interferometer with a detector is the equivalent of a dispersive element with focusing capability on impringement spots.

With respect to claims 70-72, 75-86, 90-106, 111, 114-115, 119, 121-124, 126-129 and 132-135, Examiner notes that these claims were rejected in the previous Office Action under Boppart in view of Williams and therefore, that rejection still stands.

### ***Conclusion***

As previously presented:

Lennox et al.	5,454,807
Benja-Athon	5,843,052
Tearney et al.	6,134,003

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Kish whose telephone number is 571-272-5554. The examiner can normally be reached on 8:30 - 5:00 ~ Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMK

  
ELENI MANTIS MERCADER  
SUPERVISORY PATENT EXAMINER